

Application No.: 09/475,135
Art Unit 2614

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REMARKS

Applicants thank the Examiner for the consideration given the present application.

Claims 1-26 are now present in this application. Claims 1, 11, 13, 18 and 26 are independent. Reconsideration of this application is respectfully requested.

Priority Under 35 U.S.C. § 119

The Examiner acknowledged Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document, in the previous communication mailed on February 15, 2002.

Rejections Under 35 U.S.C. §103

Claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,831,591 to Suh in view of U.S. Patent No. 6,141,003 to Chor et al. (hereinafter, "Chor") and further in view of U.S. Patent Application Publication 2002/0060749 to Funakoshi et al. (hereinafter, "Funakoshi") . This rejection is respectfully traversed.

Independent claims 1, 11, 13 and 18 all recite a method of displaying a menu in a TV screen.

In the first place, Suh does not disclose displaying a menu for anything, let alone for the TV. Suh simply does not disclose an on-screen menu. Suh only mentions a menu in terms of a screen selection menu. That disclosure is found in col. 3, lines 41-44, in connection with Figs. 3A through 3E, none of which show a menu, let alone a screen selection menu.

Moreover, Suh's disclosure in col. 1, to which the Office Action refers, only discloses that "various kinds of communication services transmitted by the VAN (value added network), such as stock market quotes, news, weather or TV information, can be viewed on the TV screen." This is certainly not a disclosure of an on-screen TV menu, either explicit or inherent. With respect to inherency, it is instructive to note that inherency cannot be based on possibilities or probabilities, but must necessarily be present.

Accordingly, Suh does not disclose the displaying of an on-screen menu feature of the invention

The claims also recite "automatically resizing said menu element to a size other than a default resize value." This feature is disclosed, for example, on pages 13-15 of the main body of Applicants' specification.

Suh clearly does not disclose such a feature.

The Office Action also admits that Suh does not set a screen as an interactive menu display screen or display an interactive menu element.

To remedy that deficiency, the Office Action alleges, with absolutely no objective evidence to support the allegation, that the use of interactive menu display screens and interactive menu elements being displayed/utilized is notoriously well known in the art.

Applicants respectfully submit that without providing objective evidence in support of this allegation in general, and with a reference that has a date prior to Applicants' effective filing date, this allegation is wholly improper in a rejection made under 35 U.S.C. §103(a) and violates the substantive and procedural due process to which Applicants are entitled under the Administrative Procedures Act. See in this regard, *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000).

The factual basis for a rejection must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

These arguments, which were presented in the Amendment filed on July 30, 2004, have not been addressed in the outstanding Office Action in direct contravention of the explicit requirement, found in MPEP 707.07(f) to discuss the merits of all such arguments in the outstanding Office Action.

This failure to comply with the explicit requirement of the MPEP must be remedied by either preparing and mailing a Supplemental Office Action, or by preparing a new Office Action, that addresses this argument on its merits.

This failure also denied Applicants fundamental substantive and procedural process under the Administrative Procedures Act. See, in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

The Office also turns to the Chor reference, which discloses one size of menu icons and one size only. Nor does Chor disclose resizing its menu icons. In fact, if there are too many icons in Chor, Chor eliminates one of those icons – see col. 9, lines 19-21, which states, “[I]f space in the favorites channels bar is limited, the least favorite channel icon may be removed with the addition of a new favorites icon.

This is objective evidence that Chor has absolutely no concept of resizing menu icons.

Applicants also respectfully submit that the Office Action has not demonstrated that one of ordinary skill in the art would be motivated, i.e., have the desire, to modify Suh in view of Chor, as suggested.

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone,

are not "evidence." See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The reason given to combine these two references is nothing more than broad conclusory statements about both references, e.g., the ability to switch from a full screen mode to a window mode of operation.

There is no clear and particular showing that one of ordinary skill in the art would have the desire to provide an on-screen interactive menu feature to Suh.

Moreover, Suh discloses no need for an on-screen interactive menu, a feature that would add unnecessary extra complexity and expense to its system .

By failing to make out a *prima facie* case of proper motivation to combine the two applied references, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

This argument, which was presented in the Amendment filed on July 30, 2004, has not been addressed in the outstanding Office Action in direct contravention of the explicit requirement, found in MPEP 707.07(f) to discuss the merits of all such arguments in the outstanding Office Action.

This failure to comply with the explicit requirement of the MPEP must be remedied by either preparing and mailing a Supplemental Office Action, or by preparing a new Office Action, that addresses this argument on its merits.

This failure also denied Applicants fundamental substantive and procedural process under the Administrative Procedures Act. See, in this regard, *In re Zurko*,

119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Furthermore, even if these two references were properly combined (which they are not, as discussed above) they would not result in the claimed invention which recites, among other features, “automatically resizing said menu element to a size other than a default resize value.”

The Office Action also states that Applicants’ arguments in the Amendment were persuasive. Yet this rejection repeats this part of the rejection despite the persuasiveness of Applicants’ arguments without explaining why this repeated rejection still is proper.

The Office Action admits that neither Suh nor Chor discloses resizing the menu element other than a default size.

In an attempt to remedy this deficiency, the Office Action turns to Funakoshi, which discloses a single CRT display that is used to display a menu. Funakoshi provides a selection means that a user can use to select an arbitrary one of a plurality of menu items that are displayed on the screen (claim 6). Funakoshi also has a display control means that changes a size or shape of display letters of the menu item selected by the selection means within a scene displayed on the screen.

The Office Action then concludes that it would have been obvious to modify the Suh/Chor reference combination that discloses an interactive menu screen

with Funakoshi by distinguishing the selected item from the non-selected menu items.

Applicants respectfully submit that the Office Action has not made out a *prima facie* case of proper motivation to modify Suh in view of Chor for reasons discussed above (and in the July 30, 2004, Amendment, which reasons have not been addressed in this Office Action).

Furthermore, Funakoshi only discloses changing the size or shape of menu display letters for a selected menu item, so that any modification of the improper base reference combination of Suh and Chor would only result in changing a user selected menu item after the user has made his or her selection.

This modified Suh/Chor reference combination does not meet or render obvious the claimed invention which recites, in independent claims 1, 11, 12, 13 and 26, among other features “automatically resizing said menu element to a size other than a default size in accordance with the size of the screen on which the menu is displayed.” Nor does the modified Suh/Chor reference combination meet or render obvious the claimed invention which recites, in independent claim 18, “automatically sizing one or more interactive icons of the interactive menu to a first size other than a default size, the first size being proportionate with a size of the menu-display screen” and “automatically resizing the interactive icons to a new size based on a ratio between the first size and the size of the menu-display screen.” These positively recited features are significantly different than what Funakoshi

does. Moreover, Funakoshi requires user input, so the resizing of a menu item is not automatic. Unless, and until, a user selects a menu item, there is no menu item resizing in Funakoshi.

Funakoshi does not resize a menu item “in accordance with the size of the screen on which the menu is displayed.” Nor does Funakoshi resize a menu item “to a new size based on a ratio between the first size and the size of the menu display screen.” Rather, Funakoshi resizes a menu element with absolutely no regard to the size of the screen on which the menu item is displayed. In fact, Funakoshi only resizes a menu item in accordance with the selection of the menu item by a user.

Accordingly, even if these three references were properly combined as suggested (and they are not at least for the un-rebutted arguments presented above and in the July 30, 2004, Amendment), they would not result in, or render obvious, the claimed invention.

Dependent Claims

Claims 2-10, 12, 14-17 and 19-21 depend, either directly or indirectly, on independent claims 1, 11, 13 and 18. Since neither Suh nor Chor discloses or suggests the above-recited features of independent claims 1, 11, 13 and 18, neither Suh nor Chor, either singly or in combination, can render claims 2-10,

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12, 14-17 and 19-21 obvious to one of ordinary skill in the art. Reconsideration and withdrawal of this art ground of rejection is respectfully requested.

Reconsideration and withdrawal of this rejection of claims 1-26 is respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants, therefore, respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Moreover, the finality of the Office Action is manifestly improper because of the failure of the Office Action to comply with the provisions of MPEP 707.07(a) for reasons discussed above. Applicants respectfully request that the finality of this Office Action be withdrawn and a new Office Action be prepared and mailed.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8034, in the Washington, D.C. area.

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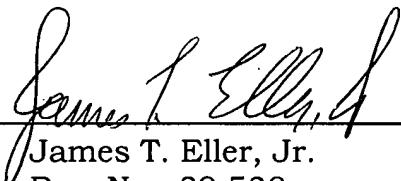
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or §1.17; particularly, extension of time fees.

Respectfully submitted,

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